

REMARKS

The Examiner's attention to the present application is greatly appreciated.

In the Office Action of December 15, 2003, the Examiner rejected the claims under 35 U.S.C. §103. No additional rejections or objections were made.

As explained in the following section, Applicant believes that the claims are patentable in view of the prior art, and that the rejection under 35 U.S.C. §103 is improper. Reconsideration, reexamination and allowance of the claims is respectfully solicited.

REJECTION UNDER 35 U.S.C. §103

The Examiner rejected Claims 1 - 6 and 9 - 14 under 35 U.S.C. §103(a) as being unpatentable over *Sharpe, III et al.*

Sharpe, III et al. discloses an electronic toy, such as a teddy bear, that includes a processor and reprogrammable memory for controlling the speech and movement of the toy. To update the toy's memory, the toy is connected by a cord to an external computer so that additional programming can be downloaded from the computer to the toy. Unfortunately, the construction includes a signal converter located within the toy which converts signals from the computer to a form usable by the toy.

Applicant's invention has eliminated the disadvantage of requiring signal converters within each toy. Instead, Applicant's claimed invention includes a computer, an appliance, and a signal converter located between the computer and the appliance. The signal converter is disengageable from the appliance so that it may be used to transfer and convert signals to any number of appliances. This construction eliminates substantial expense in the materials and construction of the appliance, which is nowhere suggested in the prior art.

According to the Office Action, the Examiner comments that locating the signal converter outside of the appliance is merely a rearrangement of parts only involving routine skill in the art, and points out that "*Sharpe, III et al.* discloses the claimed invention except

that the controller 18A of *Sharpe, III et al.* is not “located outside” of the appliance. The applicant cannot agree to such comments, and in fact, all the components of *Sharpe, III et al.* are in the appliance or the toy.

Referring to Fig. 4 of the present invention, the signal converter includes a USB receiver, a controller, and a RJ-45 cable. In addition, the flash memory is in the toy (also refer to Fig. 3), and the signal converter is independent of the toy. We disagree that locating the signal converter outside of the appliance is merely a rearrangement of parts only involving routine skill in the art, because the signal converter can be used to transfer and convert signals to an unlimited number of appliances. In other words, there is no need to buy ten teddy bears with ten signal converters according to the present invention, whereas it occurs in *Sharpe, III et al.*

Since the construction of locating the signal converter outside of the appliance eliminates substantial expense, the present invention does provide unexpected results and can be further applied to the commercial practice. We disagree that the construction is unpatentable over *Sharpe, III et al.*, because the construction is nowhere suggested in *Sharpe, III et al.* Whether the changes from the prior art are “minor”, the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee’s method and device. (*Northern Telecom, Inc. v. Datapoint Corp.*, 15 U.S.P.Q. 2d 1321, 1324 (Fed. Cir. 1990)).

As to the Examiner's comment "Note that the Applicant's originally filed specification does not even suggest that locating the controller externally or "outside" of the appliance will produce new and unexpected results", the Applicant respectfully submits that suggestion of unexpected results is not necessary because of the clear results of employing the present invention. First, the present title is "Signal Converter For Transferring Data From Computer To Appliance", and it is easy to be realized that the signal converter is located between the computer and the appliance. If not in a prejudicial viewpoint, this realization is also undoubtedly confirmed in Fig. 3 and Fig. 4 of the present invention. Second, once employing the present invention, anyone who owns a converter will not need another one, and therefore the unexpected result of eliminating substantial expense is achieved.

The Examiner rejected Claims 7, 8, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over *Sharpe, III et al.*

Claims 7, 8, 15 and 16 are depended on Claims 1 and 9 for further distinguishing the present invention from the prior art. Accordingly, the Applicant believes the pending Claims 7, 8, 15 and 16 are apparently in condition for allowance, and a notice of allowance is respectfully requested.

Based on the above comparisons, it is apparent that the present invention is very distinguishable from the *Sharpe, III et al.* patent. Thus, one skilled in the art would not be taught or suggested through the prior art disclosure to conceive the present invention.

Accordingly, Claims 1 - 16 are patentable over *Sharpe, III et al.*

In view of the foregoing remarks, reconsideration of the present patent application is respectfully requested.

CONCLUSION

The claims are believed to be in condition for allowance and notice thereof is respectfully solicited.

Since the Examiner's Office Action included a final rejection, Applicant has also filed a Notice of Appeal. The filing of the Notice of Appeal has been filed in order to provide the Examiner additional time to consider the above arguments. After such consideration, it is believed that the Examiner will agree with Applicant's conclusion that the claims are patentable in the present form.

If there are any questions that need to be resolved, it is respectfully requested that a telephone call be placed to the undersigned.

Respectfully submitted,

DRUMMOND & DUCKWORTH

A handwritten signature in black ink, appearing to read "David G. Duckworth", written in a cursive style.

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